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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,287	11/22/2000	Peter Joseph Marsico	1322/62	2195
25297	7590	04/29/2004	EXAMINER	
JENKINS & WILSON, PA 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,287

Applicant(s)

MARSICO ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 10-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 10-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-7 and 10-39 are rejected under 35 U.S.C. 101 because the claimed method for allowing a communication recipient to automatically register a complaint against a communication initiator does not recite a limitation in the technological arts. The independently claimed steps of: *receiving a call signaling message from a communication initiator; extracting a parameter from the call signaling message and generating a complaint registration message against the communication initiator if it is determined that the communication is from a communication initiator with whom communication is not desired* are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: *receiving a call signaling message from a communication initiator* may be understood as merely having a telephone conversation. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 10-12, 15, 20-22, 26, 31-32, 34-36, 38, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardon (US 5,751,800) in view of Sloo (US 5,668,953).

Ardon teaches a method and system for screening telephone calls, comprising:

Independent Claims.

Claims 1, 20 and 26. Receiving an incoming call signaling message from a communication initiator (column 3, lines 28-30); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (column 3, lines 30-35).

Also, Ardon teaches upon identifying the incoming call, executing the handling of the incoming call in accordance with instructions previously defined.

However, Ardon does not teach that said instructions include generating a complaint registration message against the communication initiator if it is determined that the communication is from a communication initiator with whom communication is not desired.

Sloo teaches a method and system for handling a complaint, including receiving and registering a complaint from the user (column 2, lines 12-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ardon to include generating a complaint registration message against the communication initiator if it is determined that the communication is from a communication initiator with whom communication is not desired, because it would allow to improve customer service by monitoring users complaints and resolving said registered users complaints in a due manner.

Dependent Claims.

Art Unit: 3629

Claim 4. See **claim 1.**

Claim 6. Extracting a parameter from the call-signaling message, wherein the parameter is telephone number for the communication initiator (column 3, lines 64-65).

Claims 10 and 21. See **claim 1.**

Claims 11-12, 22 and 31-32. See **claim 1.**

Claim 15. In response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (column 3, lines 15-19).

Claim 19. See **claim 1.**

Claim 34. See **claim 1.**

Claim 35. See **claim 1.**

Claim 36. See **claim 1.**

Claims 38, 40 and 42. See **claim 1.**

Dependent claims 3, 5, 7, 16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardon and Sloo.

Claim 3. Receiving a communication from a communication initiator (column 3, lines 28-30). Information as to *whether the communication is a SMS message* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Ardon and Sloo would be performed the same regardless *whether the communication is a SMS message, or not*. Also, it is well known to use SMS communications in call-blocking environment (See: Alperovich et al. US 5,878,338; column 5, lines 40-41).

Art Unit: 3629

Claim 5. Receiving a communication from a communication initiator (column 3, lines 28-30). Information as to *whether the communication is a facsimile message* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Also, it is well known to provide call-blocking feature from unwanted facsimile calls (See: Holiday, II US 6,385,310; column 2, lines 7-8).

Claim 7. Extracting a parameter from the call-signaling message, wherein the parameter is telephone number for the communication initiator (column 3, lines 64-65). Information as to *whether the telephone number is a mobile identification number* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Also, it is well known to provide call-blocking feature to block unwanted facsimile calls in wireless communications environment (See: Holiday, II US 6,385,310; column 2, line 12).

Claim 16. Ardon and Sloo teach: in response to receiving the call-signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (column 3, lines 15-19).

However, Ardon and Sloo do not specifically teach that notifying the communication initiator includes notifying that the complaint registration message is being sent to a complaint registration database.

Official notice is taken that it is well known to warn unwanted telemarketers (communication initiators) that further calls would result in a complaint to an appropriate authority. It is also well known that to pursue the legal action against unwanted contacts, one has to prove that the unwanted entity has been warned that said contacts are unwanted.

Art Unit: 3629

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ardon and Sloo to include notifying the communication initiator that the complaint registration message is being sent to a complaint registration database, because it would prevent the communication initiator from calling to the recipient again.

Claim 29. Ardon and Sloo teach said system adapted to generate a complaint registration message (See: **claim 1**). Information that *the complaint registration message is based on information contained in a calling party call setup signaling message* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Dependent claims 13-14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardon and Sloo in view of Mukherjee et al. (US 6,449,474).

Claims 13-14 and 33. Ardon and Sloo teach all the limitations of **claims 13-14 and 33**, except automatically identifying an enforcement agency and sending the violation notification message to the enforcement agency.

Mukherjee et al. (hereinafter Mukherjee) teaches call interception method and system, including identifying an incoming call, and handling of the identified incoming call in accordance with instructions previously defined, wherein said handling includes communicating with a law enforcement agency (column 7, lines 9-19).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ardon and Sloo to include sending the violation notification message to the enforcement agency, because it would prevent the continuous violation of corresponding governmental regulations.

Art Unit: 3629

Dependent claims 17-19, 23-25, 27-28, 30, 37, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardon and Sloo in view of Schuster et al. (US 6,650,901).

Claims 17-18, 23-25, 27 and 30. Ardon and Sloo teach all the limitations of **claims 17-18, 23-25, 27 and 30**, except that said receiving a call signaling message from the communication initiator includes receiving a session initiation protocol (SIP) message.

Schuster et al. (hereinafter Schuster) teaches a method and system for providing telephone services including call blocking (column 1, lines 32-36), wherein the session initiation protocol is used for data communication (column 10, lines 55-56).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ardon and Sloo to include receiving a session initiation protocol message, because it would allow to digitize the telephone signals for distribution over the Web, thereby distribute intelligence to terminal devices, as specifically stated in Schuster (column 3, lines 3-4).

Also, Schuster teaches:

Claim 28. Said system, including a called party communication terminal is a personal computer (column 8, line 30-32).

Claims 37, 39 and 41. Said method and system, wherein the Internet Protocol (IP) is used for communications (column 10, lines 26-27; column 11, lines 15-16).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Art Unit: 3629

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

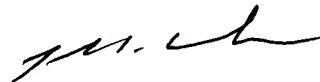
***Commissioner of Patents and Trademarks
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or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

SPB



**JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**